Serial No. 10/733,836 Confirm. No.: 2190
Art Unit: 3625 Examiner: Garg, Yogesh C.
IBM Docket: AUS920030904US1(4026)

<u>REMARKS</u>

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Claims 1-7, 15-19, and 28-35 are pending. Claims 1-7, 15-19, and 28-35 stand rejected under 35 USC §§ 102(a), 102(e), and 103(a). Applicant respectfully traverses the rejections with respect to the claims in light of the amendments with the following remarks.

<u>Claim amendments</u>

Claims 1, 3, 15, 19, 28, and 30 are amended and claims 36 through 38 are new. Support for amendments to claims 1, 3, and 30 can be found in, e.g., paragraphs 29 and 44. Support for amendments to claims 15 and 19 can be found in, e.g., paragraphs 30, 38, and 39, original claim 18, and in Fig. 2 (see elements 220, 222, 224, and 225). Support for amendments to claim 28 can be found in, e.g., paragraphs 38 and 41, original claim 18, and in Fig. 2 (see elements 220, 222, and 227). Support for new claims 36-38 can be found in, e.g., paragraphs 39-40, original claim 5, and in Fig. 2 (see element 226).

<u>Claim rejections</u>

Claims 1-2, 5-7, 15-16, 18-19, 28-29, and 32-35 stand rejected under 35 USC §§ 102(a) & 102(e) as being anticipated by Flynn U.S. Pat. App. 20010023402A1 (hereinafter "Flynn"). Applicant respectfully traverses the rejections with respect to the claims in light of the amendments with the following remarks.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference.[1] Furthermore, the identical invention must be shown in as complete detail as is contained in the claim.[2]

<u>Independent claim 1</u>

Flynn does not describe, expressly or inherently, all of the limitations of claim 1.

Independent claim 1 states:

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[1] *Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

[2] *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

A method for aggregating an e-commerce transaction, the method comprising:

receiving an electronic receipt, the electronic receipt describing a transaction to purchase a product by a purchaser from a merchant;

associating an encrypted module with the electronic receipt, the encrypted module being generated based upon content of the electronic receipt for subsequent authentication of the content of the electronic receipt of the e-commerce transaction;

gathering product information associated with the transaction; and

packaging the product information with the electronic receipt and the encrypted module to create an aggregated package to transmit to the purchaser.

The Office action states:

Regarding claim 1, Flynn teaches a method for aggregating an e-commerce transaction, the method comprising: receiving an electronic receipt, the electronic receipt describing a transaction to purchase a product by a purchaser from a merchant (see at least paragraphs 0013 and 0029-0031) gathering product information associated with the transaction, and packaging the product information with the electronic receipt to create an aggregated package (see at least paragraphs 0034 and 0035. Paragraph 0034 fairly suggests gathering product information about items to be replenished and then packaging the product information gathered about the items to be replenished with the electronic receipt to create an aggregated package of information about the items to be replenished. Paragraph 0035 fairly suggests gathering product information relating to registration of products and warranty and then packaging the product information related to warranty to create an aggregated package).

Flynn describes a system to gather routing information from the consumer during a transaction at a POS terminal such as an email address and to transmit detailed transaction information to the customer via the email address.[3] As indicated in the Office action, Flynn does not describe certifying the transaction. Similarly, Flynn does not describe "...associating an encrypted module with the electronic receipt, the encrypted module being generated based upon content of the electronic receipt for subsequent authentication of the content of the electronic receipt of the e-commerce transaction...." However, the Office action rejects claims 3, 17, and 30, which include "...certifying the transaction...", as obvious in light of Flynn and Levchin et al. (US Pat. 7,089,208),

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[3] See Flynn pars. 12-14.

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hereinafter referred to as "Levchin". With respect to claims 3, 17, and 30, the Office action states:

> Flynn teaches all the limitations of claims 1, 15, and 28..., but does not disclose certifying the transaction with a certificate of authority. However, the practice of certifying the transaction involving transfer of funds conducted [] online is well-know as shown in Levchin (see at least col. 6, lines 36-45 and col. 14, lines 16-20).

Flynn in view of Levchin also does not anticipate nor make obvious amended claim 1 because the combination of Flynn and Levchin does not teach or suggest all of Applicants' claim limitations.

To establish a prima facie case of obviousness, three basic criteria must be met.[4] First, there must be a suggestion or motivation to modify or combine the references.[5] Second, there must be a reasonable expectation of success in the modification or combination.[6] Finally, the modification or combination must teach or suggest all of Applicants' claim limitations.[7]

> As cited in the Office action, Levchin at col. 6, lines 36-45 states:

> Individual users generate transaction certificates for transactions they conduct or initiate and the system authenticates them with the users' public keys (e.g., during synchronization). A transaction certificate may include the value being exchanged, an identifier of another party to the transaction, other details (if necessary or desired), and may be signed with the user's private key. In one embodiment, a user's client computing device generates the public/key pair during user registration, and the private key is retained only on the client device.

> And, Levchin at col. 14, lines 16-20 states:

> In one method of conducting a direct value exchange, the users may exchange digital certificates (e.g., transaction certificates) or other tokens in order to authenticate each other and/or demonstrate to the system that the transaction is valid and was not spoofed or faked by one of the parties.

Levchin generates transaction certificates for transactions to authenticate the parties to each other and/or demonstrate to the system that the transactions between the

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[4] Manual of Patent Examining Procedure §2142.
[5] *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).
[6] *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).
[7] *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

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parties are valid. Amended claim 1 involves "...associating an encrypted module with the electronic receipt... for subsequent authentication of the content of the electronic receipt of the e-commerce transaction...and packaging the product information with the electronic receipt and the encrypted module ... to transmit to the purchaser." Authenticating the parties to each other and/or demonstrating to the system that the transaction between the parties is valid during the transaction is not the same as associating and packaging an encrypted module for subsequent authentication of content of an electronic receipt. Thus, Applicant respectfully requests that claim 1 be allowed.

Furthermore, as dependents of claim 1, claims 2-7 incorporate the limitations of claim 1. Thus, neither Flynn nor Flynn in view of Levchin describe or teach all the limitations of dependent claims 2-7 and Applicant respectfully argues that claims 2-7 should be allowed.

Independent claim 15

With regards to claim 15, the Office action states:

Regarding claims 15-16, 19,28-29,32-35, their limitations are closely parallel to the limitations of claims 1-2, 5-7 and are therefore analyzed and rejected on the basis of same rationale as used above for rejection of claims 1-2 and 5-7.

Amended claim 15 states:

An apparatus for aggregating an e-commerce transaction, the apparatus comprising:
a receipt processor, responsive to receiving an electronic receipt, the electronic receipt describing a transaction to purchase a product from a merchant by a purchaser, to gather product information associated with the transaction; the receipt processor comprising: an information gatherer comprising **a manufacturer application program interface to interact with a web site associated with a manufacturer associated with the product to gather product information about the product from the manufacturer based upon the electronic receipt;** and
a packager to consolidate the product information about the product from the manufacturer into an aggregated package with the electronic receipt to transmit to the purchaser.

As discussed above with respect to claim 1, Flynn describes a system to gather routing information from the consumer during a transaction at a POS terminal such as an email address and to transmit detailed transaction information to the customer via the email address.[8] In paragraph 35, Flynn also describes the possibility of the consumer contacting the manufacturer to register a product with the detailed transaction information:

> ...Product purchase information such as date and retailer are included in the detailed transaction data. **Warranty registration could be facilitated through the automatic distribution of this data to the consumer in electronic form. This data could then be forwarded with additional consumer information to the manufacturer of a specific product for the registration of the product for warranty.** This detail data can also be used to reconstruct receipts for returning merchandise to the retailer since the detailed data includes information that would allow the retailer to verify the purchase date and retailer of the original retail transaction.

But Flynn does not describe "...a manufacturer application program interface ... to gather product information about the product from the manufacturer ... and a packager to consolidate the product information ...with the electronic receipt to transmit to the purchaser." Thus, Applicant respectfully requests that claim 15 be allowed.

Furthermore, as dependents of claim 15, claims 16-19 and 35-36 incorporate the limitations of claim 15. Thus, Flynn does not describe all the limitations of dependent claims 16-19 and 35-36 and Applicant respectfully argues that claims 16-19 and 35-36 should be allowed.

Independent claim 28

With regards to claim 28, the Office action states:

> Regarding claims 15-16, 19,28-29,32-35, their limitations are closely parallel to the limitations of claims 1-2, 5-7 and are therefore analyzed and rejected on the basis of same rationale as used above for rejection of claims 1-2 and 5-7.

Amended claim 28 states:

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[8] See Flynn pars. 12-14.

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A machine-accessible medium containing instructions, which when executed by a machine, cause said machine to perform operations, comprising:

receiving an electronic receipt from a merchant, the electronic receipt describing a transaction to purchase a product by a purchaser;

identifying, via a receipt parser, the product via the electronic receipt;

gathering, via a retailer application program interface, product information associated with the product from a retailer other than the merchant based upon the identifying; and

packaging the product information from the retailer in an aggregated package with the electronic receipt to transmit to the purchaser.

As discussed above with respect to claim 1, Flynn describes a system to gather routing information from the consumer during a transaction at a POS terminal such as an email address and to transmit detailed transaction information to the customer via the email address.[9] In particular, Flynn describes the interconnection of cash registers with an in-store processor or a central office to consolidate transaction data:

> The point-of-sale terminal is connected to an in-store processor that consolidates information from multiple cash registers and provides a gateway to a wide area network. In the preferred embodiment the in-store processor sends the transaction data from multiple cash registers to a processor at the central office. Either the in-store processor or the processor at the central would then route the detailed information of each transaction to the respective customer via their e-mail address.[10]

But consolidation of transaction data in Flynn is not the same as "...gathering... product information associated with the product from a retailer other than the merchant ...; and packaging the product information from the retailer ... with the electronic receipt to transmit to the purchaser." Thus, Applicant respectfully requests that claim 28 be allowed.

Furthermore, as dependents of claim 28, claims 29-34 incorporate the limitations of claim 28. Thus, Flynn does not describe all the limitations of dependent claims 29-34 and Applicant respectfully argues that claims 29-34 should be allowed.

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[9] See Flynn pars. 12-14.
[10] Flynn par. 13.

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Independent claim 37

Claim 37 states:

A method for aggregating an e-commerce transaction, the method comprising:
receiving an electronic receipt from a merchant, the electronic receipt describing a transaction to purchase a product by a purchaser from the merchant;
gathering, via a bank application program interface, product information associated with the transaction for the product about offers associated with the bank and related to the product by interacting with a web site associated with a bank; and
packaging the product information about the offers in a format of an aggregated package with the electronic receipt for transmission to the purchaser.

As discussed above with respect to claim 1, Flynn describes a system to gather routing information from the consumer during a transaction at a POS terminal such as an email address and to transmit detailed transaction information to the customer via the email address.[11] In the rejection of claim 5, the Office action adds:

Regarding claim 5, Flynn suggests gathering product information comprises receiving the product information from at least one source of a group of sources comprising the merchant, a bank associated with the purchaser, a manufacturer associated with the product, a manufacturer having accessories associated with the product, and a retailer having accessories associated with the product (see at least paragraphs 0018-0023 which fairly disclose that the product information is gathered from POS devices belonging to merchants/retailers. Sine the claim language requires to retrieve from anyone of the listed sources, Flynn reads on this limitation as it discloses at least two sources. **Further paragraph 0005 suggests to gather product information about items purchased from bank statements and /credit/debit card statements.).**[12]

More specifically, paragraph 5, which is in the Background section of Flynn, states:

Retail establishments today provide customers a printed receipt of their transaction. The information on the printed receipt usually contains the name of the store, the date, the items purchased, the price of each item purchased, the total amount, and the amount paid by the customer.

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[11] See Flynn pars. 12-14.
[12] Emphasis added.

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Although this information is kept by the retail establishment, it is not provided to the customer in a useable electronic format. **Likewise, if the customer paid with a credit, debit or check, the consumer receives a record of the transaction in their credit card statement, bank statement, or canceled check. Again, however, this information is not provided to the customer in a useable electronic format.**[13]

According to the Office action, Flynn suggests to gather product information about items purchased from bank statements and /credit/debit card statements. But gathering information form bank or credit card statements is not the same as "...gathering, via a bank application program interface, product information associated with the transaction for the product about offers associated with the bank and related to the product by interacting with a web site associated with a bank...." Thus, Applicant respectfully requests that claim 37 be allowed.

Furthermore, as dependents of claim 37, claim 38 incorporate the limitations of claim 37. Thus, Flynn does not describe all the limitations of dependent claims 37 and Applicant respectfully argues that claim 38 should be allowed.

Dependent claims rejected under 35 USC § 103(a)

The Office action further rejected claims 3, 17, and 30 under 35 USC § 103(a) as being unpatentable over Flynn in view of Levchin. And claims 4 and 31 stand rejected under 35 USC § 103(a) as being unpatentable over Flynn in view of Horn et al. (US Pat. App. 2002/0156688 A1).

To establish a prima facie case of obviousness, three basic criteria must be met.[14] First, there must be a suggestion or motivation to modify or combine the references.[15] Second, there must be a reasonable expectation of success in the modification or combination.[16] Finally, the modification or combination must teach or suggest all of Applicants' claim limitations.[17]

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[13] Emphasis added.
[14] Manual of Patent Examining Procedure §2142.
[15] *In re Vaeck,* 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).
[16] *In re Merck & Co., Inc.,* 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).
[17] *In re Royka,* 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

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In accordance with the claim amendments, claims 3, 4, 17, 30, and 31, and new claims 34-35 and 38 are dependent upon independent claims 1, 15, 28, and 37. Applicant respectfully traverses the rejections of the independent claims, showing that the independent claims are not anticipated by either Flynn or Flynn and Levchin as discussed above. Because the 35 USC § 103(a) rejections are predicated upon anticipation of amended claims 1, 15, 28, and 37, Applicant argues that these rejections are also traversed. Thus, Applicant respectfully requests that the rejection of these dependent claims be withdrawn and they be allowed.

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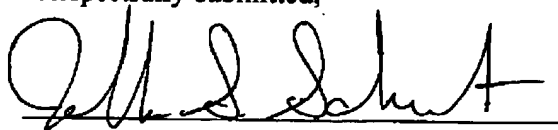CENTRAL FAX CENTER
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CONCLUSION

Applicant respectfully traverses the rejections in light of the cited references under 35 USC §§ 102 and 103. Accordingly, Applicant believes that this response constitutes a complete response to each of the issues raised in the Office action. In light of the amendments made herein and the accompanying remarks, Applicant believes that the pending claims are in condition for allowance. Thus, Applicant requests that the rejections be withdrawn, pending claims be allowed, and application advance toward issuance. If the Examiner does not believe that the claims are in condition for allowance, the undersigned attorney requests a telephone conference at (512) 288-6635.

A petition and payment for an extension of time is attached. No other fees are believed due with this paper. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 50-0563 for any such required fee.

Respectfully submitted,

April 4, 2007
Date

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